

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Claims 1, 2 and 4-7 remain pending in this application.

Claim 1 stands rejected under 35 U.S.C. §112, second paragraph, for reasons set forth in paragraph (3) of the Office Action. Reconsideration and withdrawal of this rejection are respectfully requested for at least the following reasons.

The legal standard for determining compliance with the second paragraph of 35 U.S.C. §112 is whether the claims reasonably apprise those of ordinary skill in the art of their scope. See In re Warmerdam, 33 F.3d 1354,1361, 31 USPQ2d 1754,1759 (Fed. Cir. 1994). In determining whether this standard is met, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. In re Johnson, 558 F.2d 1008,1015, 194 USPQ 187,193 (CCPA 1977).

Claim 1 specifies that the total system air flow resistance (i.e., the combination of the air flow resistance of the substrate plus the air flow resistance of the facing material) is a relatively low value and further defines that value as around between 900 to 1300 Rayls. Respectfully, Applicant submits that this is not a range within a range and that the scope of the claim would be readily apparent to those skilled in the art.

However, in an effort to expedite prosecution and solely for purpose of clarification, Claim 1 has been currently amended. In view thereof, the §112 rejection has been obviated and should be withdrawn.

Claims 1, 2 and 4-7 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,824,973 to Haines et al. in view of U.S. Patent No. 6,182,787 to Kraft et al. for the reasons given in paragraph (5) of the Office Action. Reconsideration and withdrawal of this rejection are respectfully requested for at least the reasons which follow.

Claim 1, as currently amended, is directed to a system for improved sound absorption including a substrate of porous insulation material and a facing material attached to the substrate wherein the air flow resistance of the facing material is of a relatively low value. Also, Claim 1 specifies a total system air flow resistance of around 900 to 1300 MKS Rayls. The combined disclosures of the cited art do not suggest a system as instantly claimed.

As acknowledged in the Office Action, Haines et al. '973 does not disclose or suggest a sound absorption system where the total system air flow resistance is around 900 to 1300 MKS Rayls. To the contrary, the reference only discloses a sound absorption laminate having a total air flow resistance of 740 MKS Rayls (column 7, line 26), i.e., significantly below the range set forth in the present claims. The disclosure of Haines et al. '973 teaches the art that the sound absorption characteristics of a porous insulation substrate can be enhanced through the application of a high air flow resistance facing to the

substrate (column 3, line 67 to column 4, line 3; underlining added). Claim 1 of the present application specifies a facing whose air flow resistance is a relatively low value.

According to the Office Action, Kraft et al. '787 discloses a total system air flow resistance of 20 to 100 CGS Rayls (column 4, line 64). The Action concludes that it would have been obvious to modify the laminate of Haines et al. '973 to have a total resistance of 900 to 1300 MKS Rayls in view of the teachings of Kraft et al. '787.

Respectfully, Applicant disagrees with the Examiner's characterization of the disclosure of Kraft et al. '787. The statement regarding a steady air flow resistance of about 20 to about 120 CGS Rayls in column 4, line 64 refers to the honeycomb filler material 105 located between the air-permeable facing sheet 102 and the air-impermeable backing sheet 104. Note column 4, lines 30-32 which indicates that each of the walls 108 of the cells 106 is preferably formed of a porous material that provides a desired level of air flow resistance. Further, the disclosure at column 4, lines 56-65 indicates that the porosity of the cell walls 108 must be tailored to achieve a desired level of air flow resistance through the cells 106. "Air flow resistance is specified as the steady (DC) flow resistance of the material, corresponding to a specified air flow rate through the material." The material referred to is the porous material mentioned in column 4, line 31. Thus, the air flow resistance range of 20 to 120 CGS Rayls refers to the porous insulation and not the total air flow of the system.

This conclusion is reinforced by the language in the claims of the '787 patent; note column 5, lines 21-24:

at least some of the walls being entirely porous and air-permeable to provide steady flow resistance therethrough of about 20 to 120 CGS Rayl.

Note also column 6, lines 5-8 and 49-52 thereof. Thus, Kraft et al. '787 does not teach a total system air flow resistance of around 900 to 1300 MKS Rayls.

To establish a *prima facie* case, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. See Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376,1385, 58 U.S.P.Q.2d 1286,1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select references and combine them in the way that would produce the claimed invention."); C.R. Bard, Inc. v. M3 Sys., Inc. 157 F.3d 1340,1352, 48 U.S.P.Q.2d 1225,1232 (Fed. Cir. 1998) (a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding"). Northern Telecom v. Datapoint Corp., 908 F.2d 931,934, 15 U.S.P.Q.2d 1321,1323 (Fed. Cir. 1990) (It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor."). The teachings or suggestions, as well as the second requirement, expectation of success, must come from the

prior art, not Applicant's disclosure. See In re Vaeck, 947 F.2d 488,493, 20 U.S.P.Q.2d 1438,1442 (Fed. Cir. 1991).

Moreover, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. In other words, a hindsight analysis is not allowed.

Applicants respectfully submit that the respective teachings of these two references represent only isolated disclosures with no suggestion or incentive therein that would have motivated those of ordinary skill to combine their respective teachings and arrive at the invention set forth in the present claims. Nor was there a reasonable expectation that by combining the disclosures of the cited art, one could achieve a system having improved sound absorption characteristics.

Accordingly, for at least the aforementioned reasons, the §103(a) rejection of Haines et al' 973 in view of Kraft et al. '787 should be withdrawn. Such action is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this amendment or the application in general, the Examiner is invited to telephone the undersigned at her earliest convenience.

Respectfully submitted,

JOHNS MANVILLE

By: Robert D. Touslee
Robert D. Touslee

10100 W. Ute Avenue
P.O. Box 625005
Littleton, Colorado 80162-5005
(303) 978-2000